UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,540	04/18/2001	Naoto Kinjo	Q63865	6811

7590 07/24/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213

EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,540	KINJO, NAOTO	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) *16-19 and 24-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,20-23 and 31-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the paper(s) filed 4/12/06.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15, 32-36, 38, 41, 44, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes) and Montero (US6133912).

Regarding claims 1, 2, 6, 11, 34, Eckhoff teaches bank machines which provide customized advertising as well as facial recognition technology. It is unclear whether the customization is based upon the identified user. Fridman teaches specifics of a customized ad banking system whereby user characteristics are identified biometrically, compared to stored images of the customer base and whereby customized ads are presented to the user based on this information. It would have been obvious to one of ordinary skill at the time of the invention to have provided a centralized storage of previously-captured Eckhoff's user faces so that the advertising can be targeted to the identified user in order to provide more personalized and relevant ads. Targeting ads to the identified user as suggested inherently includes taking a photograph, extracting the

face, analyzing a first characteristic (the features/shape of the face) and presenting targeted ads that match parameters of the user, however Fridman does not explicitly state how a targeted ad is selected, although he teaches that "through the use of iris recognition, the bank could then access any data base...and deliver targeted advertisements...to the customer." Montero however teaches delivering targeted ads to identified users. Montero teaches that an advertiser defines a desired target population segment such as males under 40 years of age with incomes exceeding $50k [5:13-25] and that the identified user profile is relied upon to determine if the user is within that segment (i.e. a member of that classification) in which case the user will receive a particular targeted ad. It would have been obvious to one of ordinary skill at the time of the invention to have defined a targeted classification such as males under 40 and delivered the appropriate ad for such a classification when it is decided that the user is a member of that classification population, in order to provide targeted ads as desired by Fridman, The presentation of different ads for different people, targeted for one person vs. another person is taken to provide "switching" the ad content/image in accordance with the first characteristic. The screen that shows the ads is taken to be an image display apparatus. The plurality of ATM/bank machines which provide this advertising are taken to inherently be on the bank's communication network. However it would have been obvious to one of ordinary skill at the time of the invention to have used any network for communication including the Internet as is well known.

Regarding claims 3, 4, Fridman's targeting of customized ads to users is taken to inherently include estimation of a characteristic such as "this person would likely be

receptive to this selected ad." However Montero's suggestion for deciding whether a user is a member of a defined targeted audience provides the customer classification. The user's biometric first characteristic is used to determine gender, age, etc in order to determine the user's classification and determine the appropriate targeted ad. Applicant's use of the term "estimating" is taken to be met by accessing the identified user's data in the database which is relied upon to deliver the targeted ad. Any of the segment parameters (age, gender, income) are taken to meet the estimation of the second characteristic to determine customer classification.

Regarding claim 5, the ad selected for display to the particular user is taken to be a higher priority ad than other, non-displayed ads that were not chosen for display.

Regarding claims 7, 8, 41, the ATM machine could be considered an (arcade) game apparatus where the game played by the user is "what the heck is my PIN number again?". There are no features claimed which differentiate an ATM networked computer with a computer "game apparatus".

Regarding claims 9, 10, 32, 33, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of well known display such as a television monitor with the system of Eckhoff. The displayed advertisement is inherently in a specified area of the screen. A biometrically identified user at such a TV-equipped advertising apparatus is taken to be "watching television" and the TV display is certainly a display capable of displaying a television program.

Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have stored the user profiles at a central server so that the

plurality of ATMs can access the centralized required databases and deliver advertising across the network.

Regarding claims 13-15, Fridman teaches that the targeted ads can be displayed on a screen or by hard copy (mail). It would have been obvious to one of ordinary skill at the time of the invention to have provided a hard copy of the ads to the user at the ATM by way of the well known receipt printer. As stated above, the presentation of different ads, targeted for one person vs. another person is taken to provide "switching" the ad content/image, regardless of the medium of the output.

Regarding claims 35, 36, the equipment employed is taken to meet the broad "personal computer" which does not provide any particular structural or method step limitations.

Regarding claim 38, the display of Eckhoff is taken to meet the broad "electronic information board" (as well as "electronic poster").

Regarding claim 44, the base claim (claim 20) now essentially provides the switching step as an optional one. The switching step is no longer required when there is no decision that display of the image would be prohibited. Nonetheless when ad 2 (targeted to that user's classification) is displayed it is taken by the examiner to be determined as preferable to ad 1 (targeted to other user classifications). It can be said that the system has decided that ad 1 is prohibited from display based upon classification. This is the case with the suggested combination.

Regarding claim 45, the targeting of advertising to particular classifications of customers performed by Montero's is based on the principle that "information may be

used to develop a targeted advertising strategy, where the advertisers can determine the subscribers who are *more likely* to be interested in receiving such information" [13:23-36]. This is taken to provide a teaching that the targeted ads are chosen based on statistical tendencies (i.e. people more likely to be interested in the subject matter of the ad) of members in the designated classification.

Claims 31, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes), Montero and further in view of Kanevsky et al (US6421453). Kanevsky et al teaches a biometric system for limiting access to a computer system. Kanevsky et al teaches that many biometric characteristics can be used in order to identify the user including voice print, face recognition, body geometry (e.g. height, weight, hair color, hand geometry), etc [19:8-18, 11:65-66]. It would have been obvious to one of ordinary skill at the time of the invention to have included analysis of a user's height for example in order to more accurately identify the user.

Claims 20-23, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes).

Regarding claims 20, 21, 23, Eckhoff teaches bank machines which provide customized advertising as well as facial recognition technology. It is unclear whether the customization is based upon the identified user. Fridman teaches specifics of a customized ad banking system whereby user characteristics are identified biometrically, compared to stored images of the customer base and whereby customized ads are presented to the user based on this information. It would have been obvious to one of ordinary skill at the time of the invention to have provided a centralized storage of previously-captured Eckhoff's user faces so that the advertising can be targeted to the identified user in order to provide more personalized and relevant ads. Targeting ads to the identified user as suggested inherently includes taking a photograph, extracting the face, analyzing a first characteristic (the features/shape of the face) and presenting targeted ads based upon that first characteristic. The presentation of different ads, targeted for one person vs. another person is taken to provide "switching" the ad content/image in accordance with the first characteristic. The screen that shows the ads is taken to be an image display medium. Regarding claim 20, the claim now essentially provides the switching step as an optional one. The switching step is no longer required when there is no decision that display of the image would be prohibited. Nonetheless when ad 2 is selected as the targeted ad over ad 1, then it can be said that the system has decided that ad 1 is prohibited from display. This is the case with the suggested combination.

Regarding claim 22, the targeted ad selected for display to the particular user is taken to be a higher priority ad than other, non-displayed ads that were not chosen for targeted display.

Regarding claim 42, the biometric-outfitted apparatus of the proposed combination inherently includes a computer with software in order to acquire the image of the user and perform image analysis in order to identify the user.

Regarding claim 43, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of well known display such as a television monitor with the system of Eckhoff. The displayed advertisement is inherently in a specified area of the screen. A biometrically identified user at such a TV-equipped advertising apparatus is taken to be "watching television" and the TV display is certainly a display capable of displaying a television program.

Claims 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhoff (Eckhoff, Jean, "News Briefs", 1-10-2000, "Convenience Store News," v36, n1, p14) in view of Fridman (Fridman, Sherman, "Bans Eye Iris Scan Identification Technology," 12-9-1999, Newsbytes) and further in view of Marsh et al (US6876974).

Marsh et al teaches selection of targeted ads to be displayed to an identified user. The selected ads are added to a display queue and are shown in a particular order, each for a predetermined period of time [3:15-25, 9:8-11]. It would have been obvious to one of ordinary skill at the time of the invention to have selected plural ads for the identified users of Eckhoff and shown them in a particular order so that more

advertising can be sold (as well as seen by the users). The order of the targeted ad queue is taken to define the priority of the ads.

Response To Arguments

Applicant argues that targeting ads to identified users does not inherently require analysis of a face characteristic extracted from a photograph. However in this case, the user is not simply an identified user, but a user identified using facial recognition technology which indeed inherently requires the steps in question.

Applicant argues that Montero does not require photographing a user. The examiner is however relying on the other references for such photograph-based biometric identification.

Applicant argues that Montero is non-analogous art. Examiner disagrees and relies on the teaching by Fridman that biometrics be used to provide targeted ads. Montero provides motivation by providing details of how to target segments (classifications) of the population with pertinent/targeted advertising.

Applicant argues that the same criteria used to identify an individual user in Eckhoff need not and should not be used for targeting. Examiner disagrees – the detected characteristic leads to classification which leads to selection of a targeted ad. Therefore the targeting is fairly described as being based on the characteristic.

Applicant argues that claim 1 does not require identification of a user and his profile, however the examiner is tasked with analyzing the features positively recited in these open-ended claims. Applicant argues that the invention requires "detecting", yet

the combination provides "analyzing"; however the combination also indeed provides "detecting" (prior to the analyzing).

Applicant argues that the combination requires data (a profile) separate from the biometric data. Again, features present in the art yet absent from the claims are immaterial. Examiner does not understand the "dual characteristics" of the extracted data argument, nor see any such limitation in the claims.

Applicant argues regarding claim 20 that the art can control the image data on alternative bases (other than feature extraction). Again, features present in the art yet absent from the claims are immaterial.

Applicant argues that facial recognition is possible via distance between eyes, position of nose, position of mouth, yet impossible with the characteristics of claim 2. Examiner disagrees. At least a size of a face and shape of hairs are indeed capable of being analyzed in order to accomplish facial recognition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc